

REMARKS

In an Office Action mailed on June 20, 2006, claims 42-55 were rejected under 35 U.S.C. § 112, first paragraph; claim 38 was rejected under 35 U.S.C. § 103(a) as being unpatentable over House in view of Official Notice; claims 42-55 were rejected under 35 U.S.C. § 103(a) as being unpatentable over House in view of the EMCORE; and objections were made to claims 56-62.

The claims have been amended to overcome the corresponding objections. The §§ 103 and 112 rejections are discussed below.

§ 112 Rejections:

Claims 42-55 stand rejected under 35 U.S.C. § 112, first paragraph for allegedly failing to comply with the written description requirement. In particular, the Examiner contends the specification fails to contain a written description of an online catalog that has a selector to select an unavailable product or attribute that is not offered for sale. Office Action, 3.

Applicant directs the Examiner's attention to lines 20-22 on page 6 through lines 1-5 on page 7 of the specification. This language describes at least one embodiment of an online catalog that has a selector to select an unavailable product or attribute that is not offered for sale. In particular, the specification describes a safety valve size that is "an unavailable product 34 in the form of a size not currently available from the seller." Specification, p. 6, l. 22 and p. 7, ll. 1-2. The specification further describes, "by offering the unavailable size on the online catalog 30, the seller is able to extend their line offering based upon actual market demand as opposed to simply building a new size in the hopes that someone will buy it." Thus, one skilled in the art would recognize that unavailable products are offered on the online catalog and if the market demand is not present, the product will not be sold. Thus, contrary to the Examiner's contention, the specification describes at least one product that is not offered for sale and is not necessarily available after some degree of engineering or development. For at least these reasons, claims 42-55 comply with the written description requirement.

§ 103 Rejection of Claim 38:

In the current Office Action as well as the previous Office Actions, the Examiner has failed to establish where the prior art contains the alleged suggestion or motivation to modify

House such that House's system produces or contains variance records that contain an allowed variance to an associated available product and are displayed on a visual display. Once again, the Applicant requests the Examiner to produce a reference that contains this teaching or suggestion. The existence of the alleged suggestion or motivation has never been admitted by Applicant as prior art, as the Examiner has never explicitly taken official notice to the existence of the suggestion or motivation.

Therefore, a *prima facie* case of obviousness has not been set forth for independent claim 38 for at least the reason that the Examiner fails to show where the prior art allegedly teaches or suggests the variance records of claim 38. A *prima facie* case of obviousness has not been established for independent claim 38 for at least the additional, independent reason that the Examiner fails to show where the prior art contains the alleged suggestion or motivation to modify House to derive the claimed invention. Therefore, for at least any of these reasons, Applicant requests withdrawal of the § 103 rejection of claim 38.

§ 103 Rejection of Claims 42-55:

The Examiner combines House with the EMCORE article in the § 103 rejections of claims 42-55. However, a *prima facie* case of obviousness has not been set forth for any of claims 42-55 for at least the reason that neither House nor the EMCORE article teaches or suggests using the selection of unavailable products/attributes for purposes of market research.

As conceded by the Examiner, House fails to disclose these limitations. However, the EMCORE article fails to supply the missing claim limitations. In this regard, the EMCORE article merely recites EMCORE's expansion of its transceiver array program in response to customer requests for a transponder product. However, this in no way teaches or suggests using an unavailable product selector in an online catalog for purposes of evaluating market research. EMCORE is silent regarding how the customer requests were gathered.

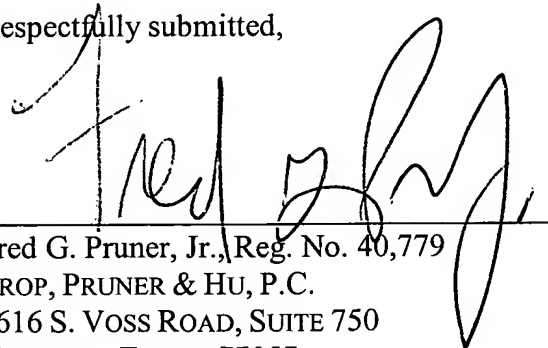
A *prima facie* case of obviousness requires more than a piece-wise combination of elements. Instead, the Examiner must show that one skilled in the art, *without knowledge of the claimed invention*, would have modified the references to derive the claimed invention, a showing must be supported by objective evidence, not mere speculation. *In re Lee*, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).. Thus, the Office Action fails to set forth why one skilled in the art would modify House, whose disclosure is not even directed to

evaluating market demand for an unavailable product, to include a product selector for an unavailable product for purposes of evaluating market research. Without this showing, a *prima facie* case of obviousness has not been established for independent claim 42 (which recites using selections of unavailable products or attributes made via the product/attribute selector as market research to determine whether to extend a product offering); or independent claim 56 (which recites a processor to compile selections of unavailable products via the user interface for purposes of market research. Claims 43-55 and 57-62 are patentable for at least the reason that these claims depend from allowable claims.

CONCLUSION

In view of the foregoing, withdrawal of the §§ 103 and 112 rejections and a favorable action in the form of a Notice of Allowance are requested. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 20-1504 (SHL.0293US).

Respectfully submitted,



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